



AP
[Signature]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Patent Application of)
Steven R. DONOVAN et al.) Group Art Unit: 2662
Application No.: 09/436,796) Examiner: G. Sefcheck
Filed: November 8, 1999)
For: METHOD AND SYSTEM FOR)
DYNAMIC GATEWAY)
SELECTION IN AN IP)
TELEPHONY NETWORK)

TRANSMITTAL FOR APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief- Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is an Appeal Brief in support of the Notice of Appeal filed August 16, 2005.

Please charge the fee of ☐ \$250.00 ☒ \$500.00 to Deposit Account No. 13-2491.

The Commissioner is hereby authorized to charge any other appropriate fees that may be required by this paper that are not accounted for above, and to credit any overpayment, to Deposit Account No. 13-2491.

Respectfully submitted,

HARRITY & SNYDER, L.L.P.

By:

Glenn Snyder
Reg. No. 41,428

11240 Waples Mill Road
Suite 300
Fairfax, Virginia 22030
(571) 432-0800

Customer No.: 25537

Date: October 14, 2005



PATENT
Attorney Docket No. RIC99060

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Steven R. Donovan et al.)	Group Art Unit: 2662
)	
Serial No.: 09/436,796)	Examiner: G. Sefcheck
)	
Filed: November 8, 1999)	
)	
For: METHOD AND SYSTEM FOR)	
DYNAMIC GATEWAY SELECTION)	
IN AN IP TELEPHONY NETWORK)	

APPEAL BRIEF

U.S. Patent and Trademark Office
Customer Window, Mail Stop Appeal Brief – Patents
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

This Appeal Brief is submitted in response to the Final Office Action mailed June 21, 2005 and in support of the Notice of Appeal filed August 16, 2005.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is MCI, Inc.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals, interferences or judicial proceedings.

10/17/2005 JAD001 00000061 132491 09436796
01 FC:1402 500.00 DA

III. STATUS OF CLAIMS

Claims 1-28 are pending in this application. Claims 11 and 12 have been indicated as containing allowable subject matter. Claims 1-10 and 13-28 are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

No Amendment has been filed subsequent to the Final Office Action mailed June 21, 2005.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Each of the independent claims involved in this appeal is recited below, followed in parenthesis by examples of where support can be found in the specification and drawings for the claimed subject matter. In addition, each dependent claim argued separately is summarized below.

Claim 1 recites: A method for routing calls to a destination gateway to establish a communication session call in a telecommunications network between a source user agent (e.g., Fig. 1, SUA 102) and a destination user agent (e.g., Fig. 1, DUA 103) over a path supported at least in part by a telephone network and an IP network, said IP network including a plurality of ingress and destination gateways, at least one proxy server, and at least one redirect server (RS) (e.g., Fig. 1, RS 104), said method comprising the steps of: a) receiving a call setup request at the at least one proxy server from the source user agent, wherein the source user agent is included in a public switched telephone network and the call set up request identifies the destination user

agent (e.g., Fig. 2, step 702, page 10, second paragraph); b) forwarding the received call setup request to the redirect server (e.g., Fig. 2, step 704, page 10, second paragraph); c) receiving routing information or a request failure response from the redirect server (e.g., Fig. 2, steps 705-707, page 10 second and third paragraphs); d) proxying the call setup request by the at least one proxy server to a destination gateway selected from said routing information upon receiving the routing information from the redirect server, wherein the selected destination gateway can communicate with a public switched telephone network that includes the destination user agent (e.g., Fig. 2, step 708, page 11, lines 1-3); e) upon proxying the call setup request to the selected destination gateway, waiting for a response from the selected destination gateway (e.g., Fig. 2, step 710, page 11, lines 3-7); f) upon receiving the response from the selected destination gateway within a predetermined time, establishing a communication session using said selected destination gateway (e.g., Fig. 2, steps 722 and 724, page 11, last line to page 12, line 3); and g) if the response is not received within the predetermined time, sending the call setup request to a succeeding destination gateway selected from the routing information and reporting failure of the selected destination gateway to the redirect server, wherein the succeeding destination gateway can communicate with a public switched telephone network that includes the destination user agent (e.g., Fig. 2, steps 714-718, page 11, second paragraph).

Claim 2 recites: The method as claimed in claim 1, further comprising repeating steps (d) to (g) until a destination gateway is determined to be available for establishing said communication session or until all destination gateways from said routing information have been determined to be unavailable (e.g., page 11, lines 15-20).

Claim 15 recites: The method as claimed in claim 1, further comprising the step of resending the call setup request to the selected destination gateway a predetermined number of times when the response is not received within the predetermined time (e.g., page 5, second paragraph).

Claim 16 recites: A system for allowing a call to be completed in a communication session between a calling party and a called party, which comprises: a first telephony system including at least one source user agent (SUA) (e.g., Fig. 1, 114a, page 9, first full paragraph); a second telephony system including at least one destination user agent (DUA) (e.g., Fig. 1, 114b, page 9, first full paragraph); an IP network connected between said first and second telephony systems (e.g., Fig. 1, 112, page 9, first full paragraph); a plurality of ingress gateways for interfacing said IP network to said first telephony system (e.g., page 9, first full paragraph); a plurality of egress gateways for interfacing said IP network to said second telephony system (e.g., Fig. 1, DGWs 110a and 110b, page 9, first full paragraph); an IP telephony proxy server for selecting one of said plurality of egress gateways for completing said call based on routing information received by the IP telephony proxy server (e.g., Fig. 1, SPS 106, page 10, first paragraph), wherein the IP telephony proxy server receives a call setup request from the source user agent that identifies the destination user agent (e.g., Fig. 2, step 702, page 10, second paragraph); an IP redirect server for providing the routing information to said IP telephony proxy server (e.g., Fig. 2, RS 104, page 10, second paragraph); and a network management system for receiving and storing status changes of destination gateways, said network management system being in communication with said IP telephony proxy server (e.g., Fig. 1, NMS 108, page 9, lines

16-17).

Claim 17 recites: The system as claimed in claim 16, wherein the IP telephony proxy server is a Session Initiation Protocol (SIP) proxy server (e.g., page 4, second full paragraph).

Claim 18 recites: The system as claimed in claim 16, wherein the IP telephony proxy server is an H.323 gatekeeper (e.g., Fig. 1, 106).

Claim 19 recites: A method for detecting an available destination gateway from a plurality of destination gateways in an IP network for completing a communication session between a source user agent (e.g., Fig. 1, SUA 102) in a public switched telephone network and a destination user agent (e.g., Fig. 1, DUA 103) in a public switched telephone network, wherein the source user agent provides a call setup request that identifies the destination user agent, said method comprising the steps of: a) transmitting a message to one of said plurality of destination gateways from a server to ascertain an availability status of said one of said plurality of destination gateways, wherein said one of said plurality of destination gateways can communicate with the public switched telephone network that includes the destination user agent (e.g., Fig. 2, step 708, page 11, lines 2-3); b) waiting for an acknowledge response from said one of said plurality of destination gateways for a predetermined period of time (e.g., Fig. 2, steps 710-712, page lines 3-5); c) determining if said one of said plurality of destination gateways is available if said acknowledge response is received within said predetermined period of time (e.g., Fig. 2, step 720, page 11, second paragraph); and d) transmitting said message to a succeeding

gateway of said plurality of destination gateways, if said acknowledge response is not received within said predetermined period of time, wherein said succeeding gateway can communicate with the public switched telephone network that includes the destination user agent (e.g., Fig. 2, steps 714-718, page 11, lines 15-20).

Claim 20 recites: The method as claimed in claim 19, further comprising repeating steps (b) to (d) until the availability status of each of said plurality of destination gateways has been determined (e.g., page 11, lines 15-20).

Claim 23 recites: The method according to claim 1, wherein the routing information identifies at least one destination gateway that can handle the call according to status information tracked by the redirect server (e.g., page 14, second paragraph through page 15).

Claim 26 recites: The method according to claim 1, wherein the redirect server tracks status of at least one destination gateway (e.g., page 14, second paragraph through page 15).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 2, 5-7, 15-17, 19, 20 and 22-28 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over White et al. (U.S. Patent No. 6,069,890; hereinafter White) in view of Thomas et al. (U.S. Patent No. 6,487,283; hereinafter Thomas).

Claims 3, 4, 8-10, 13, 14, 18 and 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over White in view of Thomas and further in view of Iwama et al. (U.S. Patent No.

6,600,735; hereinafter Iwama).

VII. ARGUMENT

A. Rejection under 35 U.S.C. § 103 based on White in view of Thomas should be reversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been realistically motivated to modify an applied reference and/or combine applied references to arrive at the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

In establishing the requisite motivation, it has been consistently held that the requisite motivation to support the conclusion of obviousness is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in the art to modify a reference or to combine references with a reasonable expectation of successfully achieving some particular realistic objective. See, for example, Interconnect Planning Corp. v. Feil, 227 USPQ 543 (Fed. Cir. 1985). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. Carella v. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986);

Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

1. Claims 1, 5-7, 24 and 25

With these principles in mind, claim 1 recites a method for routing calls to a destination gateway to establish a communication session call in a telecommunications network between a source user agent and a destination user agent over a path supported at least in part by a telephone network and an IP network, said IP network including a plurality of ingress and destination gateways, at least one proxy server, and at least one redirect server (RS). The method includes receiving a call setup request at the at least one proxy server from the source user agent, wherein the source user agent is included in a public switched telephone network and the call set up request identifies the destination user agent. Claim 1 also recites forwarding the received call setup request to the redirect server.

The Final Office Action states that White discloses the ability to establish a call between a source user 100 and a destination user 118 located in different public switched telephone systems through Internet 106 (Final Office Action – page 3). The Final Office Action also states that ingress gateway router 104 of White acts as a proxy server and Internet address database 112 acts as a redirect server (Final Office Action – page 3). Appellants respectfully disagree.

White, as discussed in the Final Office Action at page 3, discloses that source 100 may initiate a call by dialing a directory number of the called party 118 (White – col. 8, lines 30-32). White further discloses that LEC 102 connects the call to gateway router 104, which then queries Internet address database 112 for the Internet address of the destination gateway router (White – col. 8, lines 32-43). Therefore, White merely discloses that a gateway router queries an Internet

address table 112 to obtain an Internet address for a destination gateway. Such a disclosure is not equivalent to forwarding a call setup request to a redirect server, as required by claim 1. In contrast, Internet address table 112 of White is merely a database that is queried to obtain an Internet address associated with a destination gateway.

In response to similar arguments made in the previous response, the Final Office Action states that both the Internet address table 112 and the redirect server recited in claim 1 are used by the source gateway router for the purpose of collection information pertaining to a proper destination gateway to which the requested call is to be connected to through an IP network. The Final Office Action further states that the Examiner believes that the Internet address table 112 of White is equivalent to the redirect server recited in claim 1 (Final Office Action – page 10). Appellants respectfully disagree.

A redirect server, as discussed in Appellants' specification at, for example, pages 4-5, and as known to those of ordinary skill in this art, is a server that receives, for example, session initiation protocol (SIP) requests from another device, such as SPS proxy server 106 (See Appellants' Fig. 1). Internet address table 112 of White, as discussed above, does not receive any call setup requests, as required by claim 1. In contrast, Internet address table 112 of White is merely a table that is queried by gateway router 104 to obtain an address of the destination gateway router. Such an address table (i.e., table 112 in White) cannot be fairly construed as being equivalent to a redirect server based on the normal meaning of this term in the art and consistent with the use of this term throughout Appellants' specification. Further, as discussed above, White does not disclose forwarding a received call setup request to Internet address table 112, as would be required by claim 1 based on the alleged equivalence of Internet address table

112 to the redirect server recited in claim 1.

Claim 1 also recites receiving routing information or a request failure response from the redirect server. The Final Office Action states that White discloses this feature and points to col. 8, lines 32-62 for support (Final Office Action – page 3). Appellants respectfully disagree.

White at col. 8, lines 32-62, as discussed above, discloses that a caller at telephone 100 may make a call to telephone station 118. In response, end office switching system 105 connects the call to gateway router 104, which queries Internet address table 112 for the Internet address of gateway router 116. This portion of White does not disclose or suggest the use of a redirect server. Therefore, this portion of White cannot further disclose or suggest receiving routing information or a request failure response from a redirect server, as required by claim 1.

Claim 1 further recites proxying the call setup request by the at least one proxy server to a destination gateway selected from said routing information upon receiving the routing information from the redirect server, wherein the selected destination gateway can communicate with a public switched telephone network that includes the destination user agent. Since White, as discussed above, does not disclose or suggest the use of a redirect server, White cannot disclose or suggest proxying the call setup request upon receiving the routing information from the redirect server, as required by claim 1.

Claim 1 also recites if a response is not received within a predetermined time, sending the call setup request to a succeeding destination gateway selected from the routing information and reporting failure of the selected destination gateway to the redirect server. The Final Office Action admits that White does not disclose this feature (Final Office Action – page 4). The Final Office Action, however, states that Thomas discloses an IP routing engine that is able to locate

eligible destination gateways capable of terminating a voice over IP call through a prioritized list of eligible destination gateways (Final Office Action – page 4). The Final Office Action further states that Thomas discloses that if a response is not received within a predetermined period of time, sending the call setup request to a succeeding destination gateway and points to the Abstract, Fig. 2 and cols. 6-8, lines 37-64 for support (Final Office Action – pages 4-5).

Appellants respectfully disagree.

The Abstract of Thomas discloses that a centralized routing engine is able to provide a prioritized list of eligible destination gateways for a source gateway. This portion of Thomas does not disclose or suggest that if a response from a selected destination gateway is not received within a predetermined time, sending a call setup request to a succeeding destination gateway selected from routing information received from a redirect server, as required by claim 1. In contrast, this portion of Thomas merely discloses that a source gateway works through a prioritized list of destination gateways until a call is established. In addition, this portion of Thomas clearly does not disclose or suggest reporting failure of a selected destination gateway to a redirect server, as also required by claim 1.

Thomas at columns 6-8 refers to Figs. 1 and 2. It is not clear which portion of columns 6-8 is alleged to disclose the above recited features of claim 1. In any event, Appellants submit that this portion of Thomas does not disclose or suggest that if a response from a selected destination gateway is not received within a predetermined time, sending a call setup request to a succeeding destination gateway selected from routing information from a redirect server and reporting failure of the selected destination gateway to the redirect server, as required by claim 1. This portion of Thomas does disclose that preferences associated with a maximum delay that an originating

gateway is willing to tolerate may be considered when making a connection (Thomas – col. 8, lines 21-29). This delay, however, refers to a delay associated with routing signals from calling party to a called party. This time delay is not associated with receiving a response to a call setup request from a selected destination gateway.

In response to similar arguments made in the previous response, the Final Office Action states that Thomas discloses a centralized routing engine that provides a prioritized list of eligible destination gateways for a source gateway (Final Office Action – page 11). The Final Office Action further states that it “is inherent that the source gateway of Thomas will ‘work through’ (see Abstract) the provided list to the next prioritized gateway if a connection cannot be established with the highest prioritized gateway after a predetermined time or after a reported failure because there would have to be some indication that moving on to the next destination gateway in the list is necessary” (Final Office Action – pages 11-12). Appellants respectfully disagree.

The Abstract of Thomas may disclose that the “source gateway then works through the prioritized list and attempts to set up the IP telephony call with each eligible destination gateway, until the call is established” (Thomas – Abstract, last sentence). This portion of Thomas does not support the allegation that Thomas inherently performs any action if a response is not received within a predetermined time, as required by claim 1. In fact, the Final Office Action essentially admits this fact by stating that it is inherent that the source gateway works through the list if a connection cannot be established after a predetermined time or after a reported failure (emphasis added). Therefore, even if this allegation was true, this would not read on the features recited in step g of claim 1, which recites sending the call setup request to a succeeding destination gateway

if the response is not received within the predetermined time, not that a call setup request is sent in either of the two scenarios alleged to be inherent in Thomas.

Therefore, as a factual matter, the combination of White and Thomas does not disclose or suggest each of the features of claim 1.

In addition, even if, for the sake of argument, the combination of White and Thomas could be reasonably construed to disclose or suggest each of the features of claim 1, Appellants assert that the motivation to combine White and Thomas does not satisfy the requirements of 35 U.S.C. § 103.

For example, the Final Office Action states that it would have been obvious to modify the system and method of White “by providing a prioritized list of eligible destination gateways for establishing a call between a source and a particular destination based on tracked status information of the destination gateways, as taught by Thomas, thus increasing the success rate of completing the call if the optimal destination gateway is unavailable and also enabling routing options based on availability and pricing” (Final Office Action – page 5). Appellants respectfully disagree.

The motivation statement is merely a conclusory statement providing an alleged benefit of the combination. No portion of either reference is pointed to as providing objective motivation for combining White and Thomas. It is apparent that the Examiner’s approach to the ultimate legal conclusion of obviousness under 35 U.S.C. § 103 amounts to a retrospective assessment as to how the claimed invention works and then combining unrelated references to arrive at the claimed invention. This type of reverse engineering approach to the obviousness issue under 35 U.S.C. § 103 has been repeatedly judicially condemned. Uniroyal, Inc. v. Rudkin-

Wiley Corp., supra; Panduit Corp. v. Dennison Mfg. Co., supra. Absent such hindsight reasoning, one of ordinary skill in the art would not have been motivated to combine the references in the manner suggested by the Examiner.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 1 under 35 U.S.C. § 103 based on White and Thomas is improper. Accordingly, reversal of the rejection of claims 1, 5-7, 24 and 25 is respectfully requested.

2. Claim 2

Claim 2 recites repeating steps (d) to (g) until a destination gateway is determined to be available for establishing said communication session or until all destination gateways from said routing information have been determined to be unavailable. The Final Office Action apparently indicates that Thomas discloses this feature, but does not point to any portion of Thomas for support (Final Office Action – page 5). Therefore, a prima facie case has not been established with respect to claim 2.

In any event, since the combination of White and Thomas does not disclose or suggest the features recited in steps d to g, the combination cannot further recite repeating steps d to g until a destination gateway is determined to be available for establishing said communication session or until all destination gateways from said routing information have been determined to be unavailable, as required by claim 2.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 2 under 35 U.S.C. § 103 based on White and Thomas is improper. Accordingly, reversal of the rejection of claim 2 is respectfully requested.

3. Claim 15

Claim 15 recites that the method of claim 1 further comprises the step of resending the call setup request to the selected destination gateway a predetermined number of times when the response is not received within the predetermined time. The Final Office Action states that Thomas discloses this feature, but does not point to any portion of Thomas as providing support for the allegation. Therefore, a prima facie case has not been established with respect to claim 15. In any event, neither White nor Thomas discloses resending a call setup request to a destination gateway a predetermined number of times when a response is not received within a predetermined time, as required by claim 15.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 15 under 35 U.S.C. § 103 based on White and Thomas is improper. Accordingly, reversal of the rejection of claim 15 is respectfully requested.

4. Claim 23

Claim 23 recites that the routing information identifies at least one destination gateway that can handle the call according to status information tracked by the redirect server. The Final Office Action at page 5 references claim 23, but does not clearly indicate whether White or Thomas allegedly discloses this feature. Further, the Final Office Action does not point to any portion of either White or Thomas that allegedly discloses this feature. Therefore, a prima facie case with respect to claim 23 has not been established.

In any event, neither White nor Thomas discloses or suggests the use of a redirect server, as discussed in detail above. Further, neither White nor Thomas discloses or suggests that

routing information received from a redirect server identifies at least one destination gateway that can handle a call according to status information tracked by a redirect server, as required by claim 23.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 23 under 35 U.S.C. § 103 based on White and Thomas is improper. Accordingly, reversal of the rejection of claim 23 is respectfully requested.

5. Claim 26

Claim 26 recites that the redirect server tracks the status of at least one destination gateway. Similar to the discussion above with respect to claim 23, the Final Office Action does not particularly point to any portion of White or Thomas that allegedly discloses this feature. Therefore, a prima facie case with respect to claim 26 has not been established.

In any event, neither White nor Thomas discloses or suggests the use of a redirect server, as discussed in detail above. Further, neither White nor Thomas discloses or suggests that a redirect server tracks the status of at least one destination gateway, as required by claim 26.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 26 under 35 U.S.C. § 103 based on White in view of Thomas is improper. Accordingly, reversal of the rejection of claim 26 is respectfully requested.

6. Claims 16, 27 and 28

Claim 16 recites a system for allowing a call to be completed in a communication session between a calling party and a called party. The system comprises a first telephony system, a

second telephony system, an IP network, a plurality of ingress gateways and a plurality of egress gateways. The system also includes an IP telephony proxy server for selecting one of said plurality of egress gateways for completing said call based on routing information received by the IP telephony proxy server, wherein the IP telephony proxy server receives a call setup request from the source user agent that identifies the destination user agent. The system further includes an IP redirect server for providing the routing information to said IP telephony proxy server.

The Final Office Action states that ingress gateway router 104 acts as a proxy server and Internet address table 112 of White is equivalent to a redirect server (Final Office Action – page 3). Appellants respectfully disagree.

White, as discussed in the Final Office Action at page 3, discloses that source 100 may initiate a call by dialing a directory number of the called party 118 (White – col. 8, lines 30-32). White further discloses that LEC 102 connects the call to gateway router 104, which then queries Internet address database 112 for the Internet address of the destination gateway router (White – col. 8, lines 32-43). Therefore, White merely discloses that a gateway router queries an Internet address table 112 to obtain an Internet address for a destination gateway. The Internet address table 112 is not equivalent to the claimed IP redirect server recited in claim 1.

For example, as discussed above with respect to claim 1, a redirect server, as discussed in Appellants' specification at, for example, pages 4-5, and as known to those of ordinary skill in this art, is a server that receives, for example, SIP requests from another device, such as SPS proxy server 106 (See Appellants' Fig. 1). Internet address table 112 of White does not receive any call setup requests from a source user agent that identifies a destination user agent, as required by claim 16. In contrast, Internet address table 112 of White is merely a table that is

queried by gateway router 104 to obtain an address of the destination gateway router. Such an address table (i.e., table 112 in White) cannot be fairly construed as being equivalent to a server, much less a redirect server.

Claim 16 further recites a network management system for receiving and storing status changes of destination gateways, said network management system being in communication with said IP telephony proxy server. The Final Office Action addresses this feature of claim 16 at page 5, but does not indicate where this feature is disclosed in either White or Thomas. Therefore, a prima facie case has not been established with respect to claim 16.

In any event, neither White nor Thomas discloses or suggests a network management system for receiving and storing status changes of destination gateways, where the network management system is in communication with an IP telephony proxy server, as required by claim 16.

In response to similar arguments made in the previous response, the Final Office Action states that clearinghouse 50 of Thomas is interpreted as a network management system (Final Office Action – page 13). Appellants respectfully disagree.

Thomas discloses that clearinghouse 50 is a component that is configured to accept preferences and preference criteria, such as rate plans and schedules, from originating customers and terminating customers (Thomas – col. 6, lines 18-23 and Fig. 1). Thomas also discloses that clearinghouse 50 includes functionality to match an originating customer's request to terminate a call with one or more terminating customers whose pricing criteria matched those defined by the originating customer (Thomas – col. 6, lines 23-30). Thomas further discloses that clearinghouse 50 may be configured to send to originating customers a prioritized list of available terminating

customers (Thomas – col. 6, lines 34-37). None of these portions of Thomas discloses or suggests that clearinghouse 50 receives and stores status changes of destination gateways, as required by claim 16.

Thomas also discloses that clearinghouse 50 may include components of a service point 112 (including a routing engine 110), a database 120, a website hosting a call pricing center (CPC) 35 and a billing and settlement system 124 (Thomas – col. 7, lines 28-31). Thomas further discloses that a routing engine 110 associated with clearinghouse 50 may use preference information to provide originating gateway 108 with a prioritized list of terminating gateways 114a-c capable of terminating a call and that the list may be prioritized according to preferences selected by the customer (Thomas – col. 23, lines 21-36). These portions of Thomas do not disclose or suggest that clearinghouse 50 receives and stores status changes of destination gateways, as required by claim 16. In contrast, these portions of Thomas merely disclose that clearinghouse 50, which may include a routing engine, prioritize terminating gateways according to preferences set by a customer. Such a disclosure in Thomas is not equivalent to storing status changes of destination gateways, as required by claim 16.

Therefore, as a factual matter, the combination of White and Thomas does not disclose or suggest each of the features of claim 16.

In addition, even if, for the sake of argument, the combination of White and Thomas could be reasonably construed to disclose or suggest each of the features of claim 16, Appellants assert that the motivation to combine White and Thomas does not satisfy the requirements of 35 U.S.C. § 103 for the reasons discussed above with respect to claim 1.

For at least these reasons, Appellants respectfully submit that the imposed rejection of

claim 16 under 35 U.S.C. § 103 based on White and Thomas is improper. Accordingly, reversal of the rejection of claims 16, 27 and 28 is respectfully requested.

7. Claim 17

Claim 17 recites that the IP telephony proxy server is a Session Initiation Protocol (SIP) proxy server. As to claim 17, the Final Office Action admits that White does not disclose a SIP proxy server, but the Examiner takes Official Notice that it is common practice to use SIP when establishing voice over IP calls (Final Office Action – page 7). The Final Office Action further states that it would have been obvious to modify White by utilizing a SIP proxy server for establishing voice over IP calls between different domains (Final Office Action – page 7). Appellants respectfully disagree.

While Appellants agree that SIP can be used in establishing calls over the Internet, claim 17 requires more than just the mere use of a SIP proxy server. Claim 17 requires that the IP telephony proxy server for selecting one of the egress gateways recited in claim 16 is a SIP proxy server. The Final Office Action pointed to gateway router 104 as allegedly being equivalent to the claimed IP telephony proxy server. Therefore, based on the alleged equivalence of the claimed gateway router 104 to the claimed IP telephony proxy server recited in claim 16, claim 17 requires modifying the gateway router 104 to be a SIP proxy server. Clearly, gateway router 104 is not a SIP proxy server and there is also no suggestion or motivation for modifying gateway router 104 into a SIP proxy server, absent impermissible hindsight.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 17 under 35 U.S.C. § 103 based on White and Thomas is improper. Accordingly, reversal

of the rejection of claim 17 is respectfully requested.

8. Claims 19 and 22

Claim 19 recites a method for detecting an available destination gateway from a plurality of destination gateways in an IP network for completing a communication session between a source user agent in a public switched telephone network and a destination user agent in a public switched telephone network, wherein the source user agent provides a call setup request that identifies the destination user agent. The method includes transmitting a message to one of said plurality of destination gateways from a server to ascertain an availability status of said one of said plurality of destination gateways, wherein said one of said plurality of destination gateways can communicate with the public switched telephone network that includes the destination user agent. The Final Office Action has not particularly addressed this feature of claim 19.

Therefore, a prima facie case has not been established with respect to claim 19.

In any event, neither Thomas nor White discloses transmitting a message to one of a plurality of destination gateways to ascertain an availability status of the gateway, as recited in claim 19.

Claim 19 further recites waiting for an acknowledge response from said one of said plurality of destination gateways for a predetermined period of time and determining if said one of said plurality of destination gateways is available if said acknowledge response is received within said predetermined period of time. The Final Office Action admits that White does not disclose these features, but states that Thomas discloses locating eligible (in-service) destination gateways by working through a prioritized list of eligible destination gateways until a call is

established (Final Office Action – page 4). It appears that the Examiner is relying upon the Abstract, Fig. 2 and cols. 6-8, lines 37-64 of Thomas for support for allegedly teaching the features recited in claim 19.

Initially, Appellants note that claim 19 does not merely recite locating eligible gateways. Claim 19 recites transmitting a message to one of the destination gateways to ascertain an availability status. Claim 19 further recites waiting for an acknowledgement response from the destination gateway for a predetermined period of time and determining if the destination gateway is available if the acknowledge response is received within the predetermined period of time. Claim 19 further recites transmitting the message to a succeeding gateway if the acknowledge response is not received within the predetermined period of time. Thomas does not disclose or suggest these features.

For example, Thomas discloses that preferences associated with a maximum delay that an originating gateway is willing to tolerate may be considered when making a connection (Thomas – Abstract and col. 8, lines 21-29). This delay, however, refers to a delay associated with routing signals from a calling party to a called party. This time delay is not associated with receiving a response to a message transmitted to one of a number of destination gateways to ascertain an availability status of the gateway, as required by claim 19. Therefore, Thomas does not disclose or suggest the claimed transmitting, waiting, determining or transmitting steps recited in steps b-d of claim 19.

In response to similar arguments made in the previous response, the Final Office Action states that Thomas discloses a centralized routing engine that provides a prioritized list of eligible destination gateways for a source gateway (Final Office Action – page 11). The Final Office

Action further states that it “is inherent that the source gateway of Thomas will ‘work through’ (see Abstract) the provided list to the next prioritized gateway if a connection cannot be established with the highest prioritized gateway after a predetermined time or after a reported failure because there would have to be some indication that moving on to the next destination gateway in the list is necessary” (Final Office Action – pages 11-12). Appellants respectfully disagree.

As discussed above with respect to claim 1, the Abstract of Thomas may disclose that the “source gateway then works through the prioritized list and attempts to set up the IP telephony call with each eligible destination gateway, until the call is established” (Thomas – Abstract, last sentence). This portion of Thomas does not support the allegation that Thomas inherently waits for an acknowledgement response from a destination gateway for a predetermined period of time and determines if the destination gateway is available if the acknowledge response is received within the predetermined period of time, as required by claim 19. In fact, the Final Office Action essentially admits this fact by stating that it is inherent that the source gateway works through the list if a connection cannot be established after a predetermined time or after a reported failure (emphasis added). That is, the Final Office Action qualifies that the actions in Thomas take place according to either of two scenarios (i.e., a connection cannot be established after a predetermined period of time OR after a reported failure). As discussed above, Thomas clearly does not disclose or suggest determining if a connection is available based on receiving an acknowledge response being received within a predetermined period of time. The other scenario alleged to be disclosed by Thomas (i.e., determining if a connection cannot be establishing after a reported failure), even if it was supported by the disclosure of Thomas, is irrelevant to the

features recited in claim 19, since claim 19 does not recite such features.

Therefore, as a factual matter, the combination of White and Thomas does not disclose or suggest each of the features of claim 19.

In addition, even if, for the sake of argument, the combination of White and Thomas could be reasonably construed to disclose or suggest each of the features of claim 19, Appellants assert that the motivation to combine White and Thomas does not satisfy the requirements of 35 U.S.C. § 103 for the reasons discussed above with respect to claim 19.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 19 under 35 U.S.C. § 103 based on White and Thomas is improper. Accordingly, reversal of the rejection of claims 19 and 22 is respectfully requested.

9. Claim 20

Claim 20 recites features similar to claim 2. For reasons similar to those discussed above with respect to claim 2, the combination of White and Thomas does not disclose or suggest this feature.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 20 under 35 U.S.C. § 103 based on White and Thomas is improper. Accordingly, reversal of the rejection of claim 20 is respectfully requested.

B. Rejection under 35 U.S.C. § 103 based on White in view of Thomas and further in view of Iwama should be reversed.

1. Claims 3, 4, 8-10, 13, 14 and 21

The Final Office Action admits that neither White nor Thomas discloses or suggests the features in any of claims 3, 4, 8-10, 13, 14 and 21. The Final Office Action, however, relies upon Iwama as allegedly disclosing these features. Even if, for the sake of argument, the combination of White, Thomas and Iwama could be reasonably construed to disclose or suggest each of the features of claims 3, 4, 8-10, 13, 14 and 21, Appellants assert that the motivation to combine these three references does not satisfy the requirements of 35 U.S.C. § 103.

For example, Appellants assert that it would not have been obvious to combine White and Thomas for the reasons discussed above with respect to claim 1. Appellants also assert that to further modify the combination of White and Thomas to include features from Iwama would not have been obvious absent impermissible hindsight. Appellants note that no portions of any of the three references have been pointed to as providing objective motivation for combining these three references. Appellants assert that the only motivation for combining these three references comes from an attempt to reconstruct Appellants' invention based on impermissible hindsight.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claims 3, 4, 8-10, 13, 14 and 21 under 35 U.S.C. § 103 based on White, Thomas and Iwama is improper. Accordingly, reversal of the rejection of claims 3, 4, 8-10, 13, 14 and 21 is respectfully requested.

2. Claim 18

Claim 18 recites that the IP telephony proxy server is an H.323 gatekeeper. As to claim 18, the Final Office Action admits that neither White nor Thomas disclose this feature (Final Office Action – page 8). The Final Office Action, however states that Iwama discloses that an IP proxy server comprises an H.323 gatekeeper (Final Office Action – page 8). The Final Office Action, however, does not point to any portion of Iwama for support for this feature. Therefore, a prima facie case with respect to claim 18 has not been established.

In any event, claim 18 requires that the IP telephony proxy server for selecting one of the egress gateways recited in claim 16 is an H.323 gatekeeper. Iwama may disclose that gatekeeper 101 controls the reserved bandwidth for a gateway device 102 (Iwama – col. 13, lines 9-34). Such a disclosure, however, is not equivalent to the feature recited in claim 18. That is, gatekeeper 101 of Iwama is not an IP telephony proxy server that selects one of a plurality of egress gateways for completing a call, as required by claim 18.

For at least these reasons, the combination of White, Thomas and Iwama does not disclose the features of claim 18.

In addition, even if, for the sake of argument, the combination of White, Thomas and Iwama could be reasonably construed to disclose or suggest each of the features of claim 18, Appellants assert that the motivation to combine these three references does not satisfy the requirements of 35 U.S.C. § 103 for the reasons discussed above with respect to claims 3, 4, 8-10, 13, 14 and 21.

For at least these reasons, Appellants respectfully submit that the imposed rejection of claim 18 under 35 U.S.C. § 103 based on White, Thomas and Iwama is improper. Accordingly,

reversal of the rejection of claim 18 is respectfully requested.


VIII. CONCLUSION

In view of the foregoing arguments, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections of claims 1-10 and 13-28.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 13-2491 and please credit any excess fees to such deposit account.

Respectfully submitted,

HARRITY & SNYDER, L.L.P.

By: 
Glenn Snyder
Reg. No. 41,428

Date: October 14, 2005

11240 Waples Mill Road
Suite 300
Fairfax, VA 22030
Telephone: (571) 432-0800
Facsimile: (571) 432-0808

IX. CLAIMS APPENDIX

1. A method for routing calls to a destination gateway to establish a communication session call in a telecommunications network between a source user agent and a destination user agent over a path supported at least in part by a telephone network and an IP network, said IP network including a plurality of ingress and destination gateways, at least one proxy server, and at least one redirect server (RS), said method comprising the steps of:

a) receiving a call setup request at the at least one proxy server from the source user agent, wherein the source user agent is included in a public switched telephone network and the call set up request identifies the destination user agent;

b) forwarding the received call setup request to the redirect server;

c) receiving routing information or a request failure response from the redirect server;

d) proxying the call setup request by the at least one proxy server to a destination gateway selected from said routing information upon receiving the routing information from the redirect server, wherein the selected destination gateway can communicate with a public switched telephone network that includes the destination user agent;

e) upon proxying the call setup request to the selected destination gateway, waiting for a response from the selected destination gateway;

f) upon receiving the response from the selected destination gateway within a predetermined time, establishing a communication session using said selected destination gateway; and

g) if the response is not received within the predetermined time, sending the call setup request to a succeeding destination gateway selected from the routing information and reporting

failure of the selected destination gateway to the redirect server, wherein the succeeding destination gateway can communicate with a public switched telephone network that includes the destination user agent.

2. The method as claimed in claim 1, further comprising repeating steps (d) to (g) until a destination gateway is determined to be available for establishing said communication session or until all destination gateways from said routing information have been determined to be unavailable.

3. The method as claimed in claim 1, further comprising the step of recording a destination gateway status as out-of-service if the response from said destination gateway is not received within said predetermined time.

4. The method as claimed in claim 3, wherein said step of recording records said destination gateway status as out-of-service in a gateway information table stored within the RS.

5. The method as claimed in claim 1, wherein said step of receiving a call setup request at the at least one proxy server from the source user agent includes the step of addressing said call setup request to a proxy address of the at least one proxy server.

6. The method as claimed in claim 1, further comprising:
counting a number of received requests subsequent to said call setup request at the at least

one proxy server.

7. The method as claimed in claim 1, wherein the at least one proxy server comprises a Session Initiation Protocol (SIP) proxy server.

8. The method as claimed in claim 1, wherein the at least one proxy server comprises an H.323 gatekeeper.

9. The method as claimed in claim 1, wherein said step of responding to the forwarded call setup request from said at least one proxy server received at the RS includes determining the status of a group of destination gateways.

10. The method as claimed in claim 9, wherein the status of each of said group of destination gateways is one of in-service or out-of-service.

13. The method as claimed in claim 10, further including the step of sending a message from the at least one proxy server to a network manager to record the status of a destination gateway.

14. The method as claimed in claim 1, further comprising the step of forwarding a request failure response to the source user agent upon receiving the request failure response from the redirect server, and terminating the communication session.

15. The method as claimed in claim 1, further comprising the step of resending the call setup request to the selected destination gateway a predetermined number of times when the response is not received within the predetermined time.

16. A system for allowing a call to be completed in a communication session between a calling party and a called party, which comprises:

- a first telephony system including at least one source user agent (SUA);
- a second telephony system including at least one destination user agent (DUA);
- an IP network connected between said first and second telephony systems;
- a plurality of ingress gateways for interfacing said IP network to said first telephony system;
- a plurality of egress gateways for interfacing said IP network to said second telephony system;
- an IP telephony proxy server for selecting one of said plurality of egress gateways for completing said call based on routing information received by the IP telephony proxy server, wherein the IP telephony proxy server receives a call setup request from the source user agent that identifies the destination user agent;
- an IP redirect server for providing the routing information to said IP telephony proxy server; and
- a network management system for receiving and storing status changes of destination gateways, said network management system being in communication with said IP telephony proxy server.

17. The system as claimed in claim 16, wherein the IP telephony proxy server is a Session Initiation Protocol (SIP) proxy server.

18. The system as claimed in claim 16, wherein the IP telephony proxy server is an H.323 gatekeeper.

19. A method for detecting an available destination gateway from a plurality of destination gateways in an IP network for completing a communication session between a source user agent in a public switched telephone network and a destination user agent in a public switched telephone network, wherein the source user agent provides a call setup request that identifies the destination user agent, said method comprising the steps of:

a) transmitting a message to one of said plurality of destination gateways from a server to ascertain an availability status of said one of said plurality of destination gateways, wherein said one of said plurality of destination gateways can communicate with the public switched telephone network that includes the destination user agent;

b) waiting for an acknowledge response from said one of said plurality of destination gateways for a predetermined period of time;

c) determining if said one of said plurality of destination gateways is available if said acknowledge response is received within said predetermined period of time; and

d) transmitting said message to a succeeding gateway of said plurality of destination gateways, if said acknowledge response is not received within said predetermined period of time, wherein said succeeding gateway can communicate with the public switched telephone

network that includes the destination user agent.

20. The method as claimed in claim 19, further comprising repeating steps (b) to (d) until the availability status of each of said plurality of destination gateways has been determined.

21. The method according to claim 19, wherein if said acknowledge response is not received within a predetermined period of time, said availability status of said destination gateway is said to be out-of-service.

22. The method according to claim 19, wherein if said one of said plurality of destination gateways is determined to be available, then said availability status is determined to be in-service.

23. The method according to claim 1, wherein the routing information identifies at least one destination gateway that can handle the call according to status information tracked by the redirect server.

24. The method according to claim 1, wherein the call setup request identifies the destination user agent by specifying the address of the destination user agent.

25. The method according to claim 24, wherein the address of the destination user agent includes the real IP address of the destination user agent.

26. The method according to claim 1, wherein the redirect server tracks status of at least one destination gateway.

27. The method according to claim 16, wherein the call setup request identifies the destination user agent by specifying the address of the destination user agent.

28. The method according to claim 27, wherein the address of the destination user agent includes the real IP address of the destination user agent.

Appeal Brief

Application Serial No. 09/436,796
Attorney Docket No. RIC99060

X. EVIDENCE APPENDIX

None

XI. RELATED PROCEEDINGS APPENDIX

None